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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,954	08/28/2001	Ulrich Meisen	Mo-6419/LeA 34,865	5188

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EXAMINER	
RODEE, CHRISTOPHER D	
ART UNIT	PAPER NUMBER
1756	7

DATE MAILED: 09/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-7

Office Action Summary	Application No. 09/940,954	Applicant(s) MEISEN, ULRICH	
	Examiner Christopher D RoDee	Art Unit 1756	

-- Th MAILING DATE of this communication appears on the cover sh et with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-5 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in the instant claims what basis was used to determine the weight percentage of silicon. Possible bases include the weight percent of Si based on the total weight of the magnetite particle, the weight of Si based on Fe_3O_4 (see DE19702431), and the manner disclosed in US Patent 4,992,191 noting the specification passage spanning pages 2 and 3. Each of these calculation methods would give different results for the same particle. The specification provides no guidance to the manner in which silicon weight percent is determined in this application.

The same indefiniteness is present in claim 5's limitations on the amount of S and Mn. Claim 5 is further indefinite because it is unclear how the sphericity is determined. The specification provides no guidance to the manner in which sphericity is calculated or determined.

The claims are indefinite for this reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 197 02 431 considered with the description of the document on specification page 3.

The German document discloses formation of toner using low-silicon magnetites (see document col. 4, l. 63-64 & claim 9). The instant specification characterizes this magnetite as being "low-silicon". The magnetite has the same characteristics as specified in instant claim 5 noting document col. 2, l. 33-53.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Aoki *et al.* in US Patent 5,599,627.

Aoki discloses a magnetic toner having magnetite core particles with 0.10 wt % silicon (Abstract; col. 9, l. 44-54). The value of 0.10 wt %, at the lower end point of the Si content range, is disclosed with sufficient specificity to anticipate the instant claims. This Si content appears to meet the requirements of a low-silicon magnetite because the value falls within the numerical range identified in the instant specification as being "low-silicon" when referencing DE 197 02 431 (discussed above).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 7-240306.

The JP document discloses a magnetic toner having magnetic particles that contain 0.10 to 1.00 wt % silicon. Note the specific amounts of silicon present in the magnetite as set forth in the Tables. The value of 0.10 wt %, at the lower end point of the Si content range, is disclosed with sufficient specificity to anticipate the instant claims. This Si content appears to meet the requirements of a low-silicon magnetite because the value falls within the numerical range identified in the instant specification as being "low-silicon" when referencing DE 197 02 431 (discussed above).

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Tokunaga *et al.* in US Patent 5,885,740.

Tokunaga discloses a toner having a magnetite with 0.15 wt % silicon (Table 1; Abstract). The value of 0.15 wt % appears to meet the requirements of a low-silicon magnetite because the value falls within the numerical range identified in the instant specification as being "low-silicon" when referencing DE 197 02 431 (discussed above).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 15 of copending Application No. 09/944880. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims are presented in product-by-process form concerning the method of making the magnetite and this magnetite appears to fall within the scope of the instant claims. The process disclosed in the copending claims appears to be included within the scope of the process disclosed in the instant specification (pp. 4-5) for formation of the magnetite. Thus, the copending application is seen as producing a low-silicon magnetite in the process claims and claiming the product of the process in a toner in claims 14 and 15. The product of the copending claim is seen as falling within the scope of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

In examination of the instant claims the term "toner" has been given its usual and customary meaning, such as disclosed by Diamond. A toner includes a binder resin and a colorant, plus other components (e.g., charge control agent) as needed for a specific application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

CHRISTOPHER RODEE
PRIMARY EXAMINER

cdr
September 9, 2002